

REMARKS

This paper is filed in response to the Final Office Action mailed February 19, 2009 (the "Office Action"). Claims 1 through 6 and 10 through 18 were previously cancelled. Claim 22 is cancelled herein, and claims 7 through 9 and 19 through 21 are amended herein. For the reasons set for the below, Applicants submit that each of the pending claims is patentably distinct from the cited prior art and in condition for allowance. Therefore, reconsideration of the claims is respectfully requested.

Claim Rejections – 35 U.S.C. § 102

Claims 19 through 22 are rejected under 35 U.S.C. § 102(b) as being anticipated by Geng (FASEB Journal, (March 7, 2001) Vol. 15, No. 4, pp. A8) in view of Huminiecki (Genomics, 2002, Apr 79(4): 547-52). As detailed above, claim 22 is cancelled herein. Therefore, Applicants respectfully submit that the rejection of claim 22 under 35 U.S.C. § 102(b) is no longer relevant and should be withdrawn. Further, with respect to claims 19 through 21, Applicants respectfully traverse this rejection.

A claim is anticipated under 35 U.S.C. § 102(b) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single reference which qualifies as prior art under 35 U.S.C. § 102(b). *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Amended independent claim 19 recites a method of preventing angiogenesis by human vascular endothelial cells ("HMVECs"). The method recited in independent claim 19 includes "inhibiting migration of HMVECs expressing a native Robo-4 receptor, wherein inhibiting migration of said HMVECs comprises providing a Slit ligand and exposing said HMVECs to said Slit ligand such that migration of said HMVECs is inhibited." However, the Geng reference teaches only that recombinant Slit 2 facilitates the formation of vasculature. The Geng reference makes no mention of a method of preventing angiogenesis. Moreover, while Huminiecki provides teachings regarding the Robo-4 receptor, the reference does not teach a method of preventing angiogenesis. Applicants, therefore, submit that the combined teachings of Geng and Huminiecki do

not expressly or inherently teach each and every element as set forth in claim 19 or in claims 20 and 21, which depend from claim 19. Consequently, Applicants respectfully request that the rejection of claims 19 through 21 in view of Geng and Huminiecki be withdrawn.

Claim Rejections - 35 U.S.C. § 112, First Paragraph

Claims 7 through 9 and 19 through 22 are rejected under 35 U.S.C. § 112, First Paragraph. As detailed above, claim 22 is cancelled herein. Therefore, Applicants respectfully submit that the rejection of claim 22 under 35 U.S.C. § 112, First Paragraph, is no longer relevant and should be withdrawn. Further, with respect to claims 7 through 9 and 19 through 21, Applicants respectfully traverse this rejection.

It is asserted in the Office Action that the specification is not enabling and does not allow a person of skill in the art to which the invention pertains or with which it is most nearly connected to use the invention commensurate in scope with the rejected claims. The Examiner has acknowledged, however, that the specification is “enabling for a method of inhibiting migration of HMVECs.” *Office Action*, page 4. In order to speed prosecution of this application, and without acquiescing to the assertion that the specification does not enable the full scope of the previously presented claims, Applicants have herein amended claims 7 through 9 and 19 through 21 without prejudice or disclaimer. Amended claims 7 through 9 are directed to methods of inhibiting migration of HMVECs, and amended claims 19 through 21 recite methods of preventing angiogenesis by HMVECs, wherein the methods include inhibiting migration of HMVECs. Applicants respectfully submit that the specification of the present application allows one of ordinary skill in the art to practice the full scope of the subject matter recited in amended claims 7 through 9 and 19 through 21. Therefore, Applicants respectfully request that the rejection of claims 7 through 9 and 19 through 21 under 35 U.S.C. § 112, First Paragraph, be withdrawn.

Claims 7 through 9, 19 and 20 are have also been rejected under 35 U.S.C. § 112, First Paragraph, for assertedly failing to comply with the written description

requirement. In particular, it is asserted that the Applicants were not in possession of “generic means for ‘activating said Robo4 receptor’ or the generic ‘ligand capable of activating said Robo4 receptor.’” *Office Action*, page 11. Again, in order to speed prosecution of this application, and without acquiescing to the assertion that the specification does not provide full written description for previously presented claims 7 through 9, 19 and 20, Applicants have amended claims 7 through 9, 19 and 20 without prejudice or disclaimer such that the phrases “activating said Robo4 receptor” and “ligand capable of activating said Robo4 receptor” no longer appear in the claims. Moreover, Applicants respectfully submit that the specification of the present application provides full written support for the subject matter recited in amended claims 7 through 9 and 19 through 21. Therefore, Applicants respectfully request withdrawal of the rejection of claims 7 through 9, 19 and 20 under 35 U.S.C. § 112, First Paragraph.

Claim Rejections - 35 U.S.C. § 112, Second Paragraph

Claims 7 through 9 and 19 through 22 are rejected under 35 U.S.C. § 112, Second Paragraph. As detailed above, claim 22 is cancelled herein. Therefore, Applicants respectfully submit that the rejection of claim 22 under 35 U.S.C. § 112, Second Paragraph, is no longer relevant and should be withdrawn. Further, with respect to claims 7 through 9 and 19 through 21, Applicants respectfully traverse this rejection.

It is asserted in the Office Action that claims 7 through 9 and 19 through 21 fail to particularly point out and distinctly claim the subject matter regarded to be the invention. In particular, it is asserted that the “specification does not identify that material element or combination of elements which is unique to, and, therefore, definitive of ‘Robo-4 receptor.’” *Office Action*, page 12. However, it is also suggested in the Office Action that Applicants amend the claims to recite a “native Robo-4 receptor.” *See, Id.* In order to speed prosecution of this application, and without acquiescing to the assertion that previously presented claims 7 through 9 and 19 through 22 do not particularly point out and distinctly claim the subject matter regarded to be the invention, Applicants have

amended claims 7 through 9 and 19 through 21 without prejudice or disclaimer such that the claims refer to native Robo-4 receptor. As such receptor is described in detail in the specification of the present application, Applicants respectfully submit that amended claims 7 through 9 and 19 through 21 particularly point out and distinctly claim subject matter Applicants regard as being their invention. Applicants, therefore, respectfully request withdrawal of the rejection of claims 7 through 9 and 19 through 21 under 35 U.S.C. § 112, Second Paragraph.

The Office Action also includes a second rejection of claims 7 through 9 and 19 through 22 under 35 U.S.C. § 112, Second Paragraph. Specifically, it is noted that the preamble of claim 7 recites “preventing guided navigation,” and it is asserted that such terminology is not clear as to whether it refers to prevention or inhibition of guidance. Moreover, it is noted in the Office Action that the preamble to claim 19 is directed to preventing angiogenesis, while the body of the claim includes a step of preventing cellular migration. Again, in order to speed prosecution of this application, and without acquiescing to the assertion that previously presented claims 7 through 9 and 19 through 22 do not particularly point out and distinctly claim the subject matter regarded to be the invention, Applicants have amended claims 7 through 9 and 19 through 21 without prejudice or disclaimer. Applicants respectfully submit that the amended claims particularly point out and distinctly claim the subject matter regarded to be the invention. Therefore, Applicants respectfully request that the rejection of claims 7 through 9 and 19 through 22 under 35 U.S.C. § 112, Second Paragraph, be withdrawn.

Conclusion

In view of the foregoing, it is believed that all of the claims are patentable in their present form and a prompt notice of allowance for this application is respectfully requested. If the Examiner finds any remaining impediment to the prompt allowance of this application, please contact the undersigned attorney.

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Respectfully submitted,

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